

REMARKS

Amendments

Claims 10 and 11 have been amended to overcome the Examiner's objections under 35 U.S.C. 112, as further explained below. The corresponding passage in the specification has been likewise amended.

The Rejections under 35 U.S.C. 112

Applicant respectfully traverses the rejections of claims 2,5 and 10-14 under 35 U.S.C. 112, insofar as the rejections are applicable to the amended claims.

The first of the rejections is based upon the Examiner's perception that there is no description in the specification of at least one alkyl acrylate or methacrylate in which the alkyl group is not an n-alkyl group containing 10 to 50 carbon atoms. As noted above, Claim 10 has been amended to replace "10 to 50 carbon atoms" by "12 to 50 carbon atoms", and it is submitted that there is indeed basis for the amended Claim 10, and, therefore, basis also for claims 2, 5 and 11-14.

As was briefly noted in the Reply mailed Aug. 21, 2000, when Claim 10, and the corresponding amendment to page 6, were first presented, it is submitted that Claim 10 does not add new subject matter to the application as filed, having regard to the documents incorporated by reference on page 6, lines 11-20, of the specification as filed, in particular U.S. Patent No. 5,412,035, a copy of which is attached. Column 13, lines 23-68, of U.S. Patent No. 5, 412,035 is particularly relevant. It describes the well-known SCC polymers which are, according to page 6, line 11, of this application, "used in the present invention". The SCC polymers are "broadly defined as polymers which

comprise repeating units of the general formula



wherein Y is "part of the polymer backbone and Cy is a crystallizable moiety, which "may be connected to the polymer backbone... through... an ester link" and is for example "alkyl of least 10 carbons ". The SCC polymer "may also contain other repeating units". In preferred SCC polymers, the side chains comprise "linear polymethylene moieties containing 12 to 50... carbon atoms" and "can be prepared by polymerizing one or more corresponding linear aliphatic acrylates, methacrylates... optionally with one or more other monomers selected from other alkyl acrylates, methacrylates... Such other monomers are generally present in total amount less than 50 % "(emphasis added). Page 10, lines 43-44, notes that percentages are by weight.

It is submitted that, in view of the disclosure noted above in the documents incorporated by reference in the application as filed, in particular the explicit antecedent basis for the negative limitation in Claim 10, the rejection under 35 U.S.C. 112 should be withdrawn.

The Examiner's second rejection is based upon the language in Claim 10. The Examiner is thanked for his careful attention to that wording, which has now been changed to make it clear that the polymer can be a homopolymer or a copolymer, must contain at least 50% by weight of units derived from the long chain n-alkyl acrylate or methacrylate, and optionally contains, in amount less than 50% by weight, units derived from the other alkyl acrylate or methacrylate

The Rejection under 35 U.S.C. 102/103

Applicant respectfully traverse the rejection of claims 1,2, 5, 6, 8-16, 18 and 19 under 35 U.S.C. 103 as unpatentable over Kao Corp. JP-4-100534A, for the following reasons.

The Kao Corp. reference requires that the polymeric thickener should be a copolymer containing both perfluoroalkyl groups and alkyl groups. Claim 10 requires that the polymeric thickener "consists essentially" of units derived from alkyl acrylates or methacrylates in which the alkyl groups are n-alkyl groups containing 12 to 50 carbon atoms, and optionally alkyl acrylates or methacrylates in which the alkyl groups which are not n-alkyl groups containing 12 to 50 carbon atoms. The term "alkyl group" does not include perfluoroalkyl groups. Thus Claim 10 excludes the possibility that the polymeric thickener includes the perfluoroalkyl groups which are essential to the reference. It is submitted that, under these circumstances, the rejection under 35 U.S.C. 102 must be withdrawn.

With regard to the rejection under 35 U.S.C. 103, Applicant previously argued that the Kao reference teaches away from the invention defined in Claim 10, because Kao teaches that, in order to obtain useful results, it is essential that the polymeric thickener contains both perfluoroalkyl groups and alkyl groups. The Examiner has not pointed to any error in the Applicant's previous argument, but has argued that since "the specification states that the claimed thickener can contain perfluoroalkyl groups, the presence of these groups would not materially affect the basic novel characteristics of the product defined in the balance of the claims". Applicant is not entirely sure what the Examiner means by this statement. However, it is clear that the Examiner's argument is based upon the disclosure of the specification itself, not the disclosure of the prior art. It is well-settled law that a rejection under 35 U.S.C. 103 cannot be based upon information which is provided for the first time by the applicant. Under these circumstances, it is submitted that the rejection under 35 U.S.C. 103 must also be withdrawn.

INFORMATION DISCLOSURE STATEMENT

On March 16, 2001, the Applicant for this application, Steven P. Bitler, together with a second inventor, David D. Taft, filed a continuation-in-part (CIP) application of

this application. A copy of that CIP application is attached. As the Examiner will see, there is substantial overlap between the claims of the CIP application and the claims of this application as filed, and as now amended. Inquiries made in connection with the preparation of the CIP application made it clear that David D. Taft should be named as a coinventor in the CIP application and indicated that David D. Taft should have been named as a coinventor in this application when it was filed. However, those inquiries also made it clear that David D. Taft is not a coinventor of the subject matter of the claims now in this application, having regard to the fact that those claims require that the defined polymer is "substantially free of functional groups".

Applicant and the undersigned believe

- (1) that the omission of David D. Taft as an inventor (of the claims originally filed in this application) was an unintentional error made without deceptive intent;
- (2) that the omission of David D. Taft as an inventor (of the claims originally filed in this application) was not a material misrepresentation which the Examiner would have regarded, or should now regard, as important to his examination of the application; and
- (3) that David D. Taft is not a coinventor of the claims now in this application.

Applicant submits that, under these circumstances, it is unnecessary to undertake the procedures required to name David D. Taft as a coinventor of the claims originally filed, and then to remove David D. Taft as a coinventor in view of the restriction of the claims to polymers which are "substantially free of functional groups".

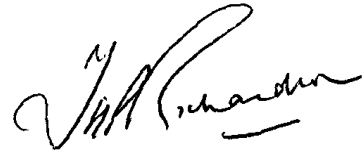
If the Examiner disagrees with Applicant's submission and wishes the Applicant to undertake the procedures needed first to name, and then to remove, David D. Taft as a coinventor, he is asked to call the undersigned, so that any necessary action can be taken.

It is believed that this Disclosure complies with the requirements of 37 CFR 1.56 and 1.97. If for some reason the Examiner thinks otherwise, he is asked to call the undersigned so that any deficiencies can be remedied.

CONCLUSION

It is believed that this application is now in condition for allowance, and such action at an early date is earnestly requested. If, however, there are any outstanding issues which could usefully be discussed by telephone, the Examiner is asked to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'T. H. P. Richardson', with a stylized flourish at the end.

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